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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,382	04/01/2004	Larry G. Ingraham	44018-0002	8271
30734	7590	05/16/2006		
BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304			EXAMINER DAVIS, CASSANDRA HOPE	
			ART UNIT 3611	PAPER NUMBER

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,382

Applicant(s)

INGRAHAM, LARRY G.

Examiner

Cassandra Davis

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, drawn claims 12-18 and 20 in the reply filed on November 21, 2005 is acknowledged. The traversal is on the ground(s) that a search and examination of an entire application can be made without serious burden. This is not found persuasive because the application contains claims drawn to two different inventions. Group I is drawn to a method of making a sign and Group II (the elected invention) is drawn to the sign, wherein the method claim include limitation that are not recited and/or needed in the claim drawn to the sign. As a result, the search for the invention of the Group I is different from the search required to Group II.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-4 and 6-11 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 20, it is unclear what structural elements comprise the "conventional baseboard product" and the "safety content".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Studen, U. S. Patent 3,280,499.
7. Studen teaches a device comprising a three-dimensioned element defining a signage recipient base element (blank 2) and a plurality of signage donor element (portions 14-22), wherein the base element has a plurality of apertures 5-13. The base 2 and donor elements 14-22 are constructed of expanded polyethylene such that the donor element

frictionally fit with the apertures 5-13 of the base 2. The friction fit corresponds to the claimed snap-in fit. The donor element has a color different than the color of the base. See column 1, lines 48-55.

8. With respect to claim 13, Studen teaches the donor element comprises a plurality of sub-parts (each indivisible punched portion 5-13 and the stencil-like portion or apertures comprises a plurality of separate sub-portions 14-22, with each sub-portion or aperture of the base element having inserted therein one of the donor element sub-parts.

9. With respect to claim 14-16, Studen teaches the color of the donor elements is different than the base element.

10. With respect to claim 20, since the applicant does claim what comprises the "conventional baseboard product" and "the safety content", the polyethylene material in which the device taught by Student is made is consider to the correspond or meet the claimed limitations.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Studen in view of Forbes et al., U. S. Patent 6,626,678. Forbes et al teaches a base 42, a frame 43 secured to the base and having a plurality of apertures and a plurality of tiles 44 adapted to fit within the apertures. Each tile has a layer of soft fabric with different tactility. Forbes also teaches that each tile is distinguishable by color or by the presence of indicia on the textured surfaces. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the device taught by Studen with each donor element further be distinguishable by tactility, color, or indicia to provide a means identify one donor or tile element from another.

13. Claim 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright, U. S. Patent 2,535,619 in view of Studen.

14. Wright teaches a toy comprising a base member 10 having a plurality of cutouts and a plurality of donor element or segments 11, wherein each segment has a different thickness than the base member. Studen teaches a device with frictionally fit donor element. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the toy taught by Wright with the donor member made of a

polyethylene material as taught by Studen to provide a friction fit or snap fit between the donor element and the base.


Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following U. S. Patents are cited to show device with a base element and a donor element: Boogher – 2,411,187; Mattenson – 3,992,010; Figone et al. – 5,441,262.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 571-272-6642. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cassandra Davis
Primary Examiner
Art Unit 3611

CD
May 11, 2006